

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No.: 7,101,550

Inventors: Clive Wood et al.

Art Unit: 1644

Serial No: 10/068,215

Attorney Docket No. DFS-067.02

Filed: February 6, 2002

Examiner: OUSPENSKI, ILIA I

For: PD-1, A RECEPTOR FOR B7-4, AND
USES THEREFOR

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Sir:

Patentees request reconsideration under 37 C.F.R. § 1.705(d) of the patent term adjustment (“PTA”) indicated in the Issue Notification and in the patent upon issuance. The Commissioner is authorized to charge the fee required under 37 C.F.R. § 1.18(e), or any other fee required by the filing of this paper, to Deposit Account No. 06-1448, ref. DFS-067.02.

The patent issued with an indicated PTA of 287 days. For the reasons given below, Patentees request correction of the PTA to 402 days, or, in the alternative, to 375 days, 334 days, 314 days, or 307 days.

This Request is timely because (1) it is filed within two months of the patent’s issuance,¹ and (2) it raises only issues that could not have been raised in a request under 37 C.F.R. § 1.705(b), as it concerns issues that arose after the mailing of the Notice of Allowance.

¹ The patent issued on September 5, 2006. The date which was two months after this date, November 5, 2006, was a Sunday. This request is timely filed on the next succeeding business day. *See* 37 C.F.R. § 1.7(a).

A. Statement of Facts

1. Correct PTA and bases under § 1.702.

The correct PTA is 402 days, or, in the alternative, 375 days, 334 days, 314 days, or 307 days. The patent is entitled to PTA under 37 C.F.R. § 1.702(a)(1) and under 37 C.F.R. § 1.702(b).

2. Relevant dates as specified in §§ 1.703(a)-(e) and adjustment as specified under 1.703(f).

- a. Application No. 10/068,215 was filed on February 6, 2002.
- b. The Notice of Allowance was mailed on February 22, 2006 and included a determination, with which Patentees agree, that the PTA to that date was 296 days.
- c. The Examiner initiated an interview with attorneys/agents of record on April 24, 2006 and expressly requested the filing of an amendment to correct informalities in the specification.
- d. Patentees filed an Amendment after Allowance under 37 C.F.R. § 1.312 on April 25, 2006.
- e. The Issue Fee payment was filed on May 22, 2006, along with a set of formal drawings.
- f. The PTO mailed a Response to the Amendment after Allowance on June 9, 2006, which was 46 days after the Amendment was filed or 27 days after the formal drawings were filed.
- g. The Issue Notification was mailed on August 16, 2006, which was 87 days after the formal drawings were submitted. The Issue Notification indicated a revised patent term adjustment of 287 days.
- h. The application issued as U.S. Patent No. 7,101,550 on September 5, 2006, which was 107 days after the formal drawings were submitted, or 576 days after the date which was three years after the filing date.
- i. The PTA under § 1.702(b) is reduced from 576 days to 125 days, pursuant to § 1.703(f), because it overlapped for 451 days with the PTA awarded under § 1.702(a)(1).

3. The patent is not subject to a terminal disclaimer.

4. Circumstances constituting failure to engage in reasonable efforts.

a. As stated above, Patentees filed an Amendment after Allowance under 37 C.F.R. § 1.312 on April 25, 2006. As discussed below, Patentees dispute whether this act constitutes failure to engage under § 1.704(c)(10). A Response to the Amendment after Allowance was mailed June 9, 2006, or 46 days later.

b. As stated above, Patentees filed formal drawings with the issue fee payment on May 22, 2006. This act may be considered to constitute failure to engage under § 1.704(c)(10).

c. The two acts listed immediately above overlapped one another by 19 days.

B. Argument

Patentees request correction of the PTA on two theories: (1) the filing of the Amendment after Allowance did not constitute failure to engage because the Amendment was filed at the Examiner's express request; and (2) the delay caused by filing the formal drawings with the issue fee should have been tolled by either the mailing of (a) the Response to the Amendment after Allowance, or (b) the Issue Notification.

1. The filing of the Amendment after Allowance did not constitute failure to engage because the Amendment was filed at the Examiner's express request.

The Examiner specifically contacted the agents/attorneys of record to request entry of an amendment to correct informalities in the specification. A copy of the interview summary is available in the Image File Wrapper. As discussed in § 1.704(c)(8), a supplemental reply filed at the Examiner's express request is not considered to constitute failure to engage. The Amendment after Allowance in this case may be considered a supplemental reply to the Amendment after Final Action filed February 2, 2006. Consequently, no part of the 46-day delay from the filing of the Amendment to the mailing of the Response should be attributed to Patentees.

The PTA should be increased by a number of days that depends on whether one of the other corrections requested herein is granted. If no other correction is made, then the PTA should be increased by 27 days, to a total of 314 days.

2. The delay caused by filing the formal drawings with the issue fee should have been tolled by either the mailing of (a) the Response to the Amendment after Allowance, or (b) the Issue Notification.

a. The Response to the Amendment after Allowance tolled the delay.

Patentees filed formal drawings on May 22, 2006, so they were available for review by the Examiner when considering the Amendment after Allowance. The Examiner's Response to the Amendment was the next paper mailed by the Office in the application. For these reasons, it is reasonable to infer that the Examiner reviewed and approved the formal drawings as part of issuing the Response to the Amendment after Allowance. Consequently, the Response should be considered the responsive paper issue by the Office under § 1.704(c)(10)(i).

Moreover, on the same day as the Response to the Amendment after Allowance was mailed (June 9, 2006), the application was tagged as "Considered Ready for Issue," as shown in the PAIR/PALM Transaction History for the patent. This status change indicates that the Office had acknowledged that nothing further was required from Patentees in order to pass the case to issuance. Hence, the delay attributable to Patentees ended no later than June 9, 2006, and it would be unfair to attribute any portion of the subsequent delay to Patentees. To the extent that the rules must be suspended to grant this relief, the present request may be considered a petition under 37 C.F.R. § 1.183 to suspend the rules, and the Commissioner is authorized to charge the fee required under 37 C.F.R. § 1.17(f) to Deposit Account No. 06-1448, ref. DFS-067.02.

On this theory, and if the Amendment after Allowance is not considered as constituting failure to engage, the total post-allowance delay attributable to Patentees is the period from the filing of the formal drawings to the mailing of the Response to the Amendment after Allowance, or 19 days instead of 134 days, which would result in an increase in the PTA of 155 days to 402 days. If the Amendment after Allowance is considered to constitute failure to engage, then the 27 days from the filing of the Amendment to the filing of the formal drawings is attributable to Patentees, whose total attributable delay would then be 46 days instead of 134 days, which would result in an increase in the PTA of 88 days to 375 days.

b. The Issue Notification tolled the delay.

Even if the Response to the Amendment after Allowance is not considered the responsive notice under § 1.704(c)(10)(i), the Issue Notification should be so considered. The Issue

Notification was an indication to Patentees that the Office had scheduled issuance of the patent on September 5, 2006, and that no further information or submission was required from the Applicant to complete the issuance process. The formal drawings must have been reviewed and accepted; otherwise, the Office of Patent Publication would not have authorized the mailing of the Issue Notification. Hence, any delay attributable to Patentees did not occur once the Issue Notification had been mailed and final preparations for issuance were underway.

On this theory, and if the Amendment after Allowance is not considered as constituting failure to engage, the total post-allowance delay attributable to Patentees is the period from the filing of the formal drawings to the mailing of the Issue Notification, or 87 days instead of 134 days, which would result in an increase in the PTA of 47 days to 334 days. If the Amendment after Allowance is considered to constitute failure to engage, then the 27 days from the filing of the Amendment to the filing of the formal drawings is attributable to Patentees, whose total attributable delay would then be 114 days instead of 134 days, which would result in an increase in the PTA of 20 days to 307 days.

For the reasons given above, Patentees ask the Office to correct the PTA to 402 days, or, in the alternative, to 375 days, 334 days, 314 days, or 307 days.

Respectfully submitted,
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